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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,004	11/28/2001	Christopher A. Julian	017516-002580US	3890
20350	7590	11/17/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			JACKSON, GARY	
TWO EMBARCADERO CENTER				
EIGHTH FLOOR			ART UNIT	
SAN FRANCISCO, CA 94111-3834			PAPER NUMBER	
			3731	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/998,004	JULIAN ET AL.	
	Examiner	Art Unit	
	Gary Jackson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-17, 19-30, 33-44, 47-53, 55-60, 75, 76, 78, 80-87 and 103-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 143-150 is/are allowed.
- 6) ☒ Claim(s) 1,3-17, 19-30, 33-41, 43, 44, 47-50, 53, 75, 76, 80-87 and 103-150 is/are rejected.
- 7) ☒ Claim(s) 42, 51 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*Gary Jackson*

### **DETAILED ACTION**

This action is a response to applicant's amendment filed June 14, 2004. The indicated allowability of the claims is withdrawn in view of the newly discovered reference(s) to Castañeda et al (US Patent 6,464,691). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Castañeda et al (US Patent 6,464,691). The patent to Castañeda et al discloses a tissue stabilizer having first and second toe portions rotatably adapted for insertion into an endoscope. See figure 21. Concerning claim 3, giving the phrase "ring mount" the broadest interpretation, many of the elements in Figure 19 are considered "ring mounts" For instance element 530 is considered a "ring mount".

#### ***Claim Rejections - 35 USC § 103***

Claims 6-17, 19-41, 43-44, 47-50, 53, 55-60, 75-76, 78, 80-87 and 103-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castañeda et al in view Boone et al (US Patent 6,740,028). The patent to Boone et al teaches the use of an adjustable "ankle coupling" that allow for manipulation of the toe portions. The latter reference also utilizes a series of interlocking balls that allow for adjustment of the foot portions. Boone further suggests irrigation and suction lumens ports for the device. The Castañeda et al and Boone et al combination suggest each of the limitations recited in the claims above. It would have been obvious to one

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having ordinary skill in the art to modify Castañeda et al with articulating balls that house the split balls as suggested by Boone et al.

***Allowable Subject Matter***

Claims 42 and 51-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 143-150 are allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Antoine Nguyen can be reached on (571) 272-4693. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson  
Primary Examiner  
Art Unit 3731



gj  
November 15, 2004